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(to be used for all correspondence after initial filing)

Application Number	09/997,034
Filing Date	11/28/2001
First Named Inventor	JENS GRIESWALD
Art Unit	2616
Examiner Name	Shick C. Hom
Attorney Docket Number	7123-US

Total Number of Pages in This Submission **15**

ENCLOSURES (Check all that apply)

- [✓] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
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- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
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- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
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- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [✓] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
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  1. Sent by Express Mail #EV 529652568 US
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Remarks
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Tektronix, Inc.
Signature	*Thomas F. Lenihan*
Printed name	Thomas F. Lenihan, Reg. No. 32,152 for Matthew D. Rabdau
Date	OCTOBER 23, 2006
Reg. No.	43,026

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FEE TRANSMITTAL
For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT	($)	500.00

Complete if Known

Application Number	09/997,034
Filing Date	November 28, 2001
First Named Inventor	JENS GRIESWALD
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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	Small Entity Fee ($)	SEARCH FEES Fee ($)	Small Entity Fee ($)	EXAMINATION FEES Fee ($)	Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____	x _____ =	.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____	x _____ =	.00

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims

Fee ($)	Fee Paid ($)
_____	.00

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
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4. OTHER FEE(S)

Non-English Specification, $130 fee (no small entity discount)

Fees Paid ($)

Other (e.g., late filing surcharge): APPEAL BRIEF _____   500.

SUBMITTED BY

Signature	*Thomas F. Lenihan*	Registration No. (Attorney/Agent) 43,026	Telephone 503-627-5068
Name (Print/Type)	Thomas F. Lenihan, Reg. 32,152 for Matthew D. Rabdau		Date October 23, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **JENS GRIESWALD**

Serial No.: **09/997,034**

Filed: **November 28, 2001**

Art Unit: **2616**

Examiner: **SHICK C. HOM**

For: **CIRCUIT ARRANGEMENT FOR TESTING A COMMUNICATION SYSTEM**

October 24, 2006

Mail Stop: Appeal Brief - Patents
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APPEAL BRIEF

This is an appeal from the Examiner's decision finally rejecting the claims in the above-identified application over prior art.

Real Party in Interest

The name of the real party in interest in this appeal is Tektronix, Inc., an Oregon corporation.

Related Appeals and Interferences

There are no prior and pending appeals, interferences or judicial proceedings known to Appellant, Appellant's legal representative or Appellant's assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims

Claims 1-10 currently stand rejected under prior art, and are the claims being appealed.

Status of Amendments

The amendment filed subsequent to the Examiner's final rejection has been entered by the Examiner.

Summary of Claimed Subject Matter

Appellant's invention is a circuit arrangement for testing a communication system where the communication is subdivided into functional layers, such as the OSI (Open Systems Interconnection) communication model. The circuit arrangement **16** has a port **32** that allows a test apparatus **28** to communicate directly with a layer higher than the physical layer without the communication previously having to pass through the first layer **14**. (Fig. 6; Abstract) The circuit arrangement may be in a switch that outputs response data to the test apparatus for analysis. The response data may be monitoring data or may be data generated in response to a stimulus provided by the test apparatus. (Page 8, lines 22-23)

Grounds of Rejection to be Reviewed on Appeal

Whether claims 1 and 6 are anticipated under 35 U.S.C. 102(e) by McElhaney, Jr. et al ("McElhaney") U.S. Patent No. 6,823,479?

Argument

35 U.S.C. 102(e) provides in pertinent part that "[A] person shall be entitled to a patent unless . . . the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." "A claim is anticipatory only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987)

The Examiner relies upon McElhaney which teaches a network fault analysis tool that is used to schedule and run proactive tests to identify network problems before subscribers are affected, as well as to provide testing on demand to quickly isolate the root cause of a problem identified by the tool or by network management systems or subscribers. The tool is topology independent, and only sends traffic as directed by a network engineer.

More specifically the McElhaney tool provides active testing capabilities across Open Systems Interconnection (OSI) layers two through seven for both basic connectivity and performance as well as common Internet applications. The tool is a hardware/software system that includes protocols, commands, Internet test function libraries, test applications, user interfaces and an Application Program Interface (API). The tool is connected to the Internet in order to send and receive information from web sites connected to the Internet. In other words the tool sends and receives via the physical layer, i.e., communicates with the device being tested through OSI layer one.

Claims 1 and 6:

The Examiner concludes that, because McElhaney recites that the tool is topology independent for providing active testing across OSI layers two through seven, McElhaney clearly reads directly on Appellant's claims 1 and 6 which recite that the test apparatus communicates "directly with any layer that is higher than a first layer of the functional layers without the communication previously having to pass through the first layer." However Fig. 1 clearly shows that the McElhaney tool

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connects to the Internet and not to a port that allows communication *directly* with layers two through seven, i.e., McElhaney necessarily has to communicate with the network via the physical or first layer, contrary to the Examiner's conclusion.

The claim language cannot be read in a vacuum to encompass more than is described in the specification. Appellant's Fig. 6 clearly shows that the test apparatus **28** is coupled *directly* via a port **32** to a device being tested **16** at functional layers above the physical or first layer **14**. This clearly supports the claim language of communicating "without the communication previously having to pass through the first layer." The Examiner's interpretation of McElhaney would negate this language in claims 1 and 6. Although McElhaney tests layers two through seven, McElhaney does so by communicating via the physical or first layer as in Appellant's described prior art. Therefore claims 1 and 6 are deemed to be allowable as being neither anticipated nor rendered obvious to one of ordinary skill in the art over McElhaney.
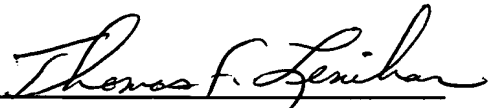
Claim 6:

Claim 6 further specifically recites the testing of a switch, with the switch containing "a circuit arrangement having a port that allows communication by a test apparatus." McElhaney does not disclose a switch having such a specific circuit arrangement that allows communication with a test apparatus "directly with any layer that is higher than a first layer of the functional layers." McElhaney only discloses a tool that is equivalent at best with the test apparatus, and does not teach or suggest that an element of the network, such as a switch, have a special circuit arrangement so that the tool can connect directly to the switch without having to go through the Internet, i.e., without first passing through the first functional layer. Therefore claim 6 is further deemed to be allowable as being neither anticipated nor rendered obvious to one of ordinary skill over McElhaney.

Conclusion:

Thus Appellant submits that claims 1 and 6, together with claims 3-5 and 7-10 dependent therefrom, are allowable, and Appellant urges that the Examiner's rejection of claims 1-10 be reversed and this case be passed to issue.

Respectfully submitted,

JENS GRIESWALD

By_____

Thomas F. Lenihan, Reg. No. 32,152
For Matthew D. Rabdau, Reg. No. 43,026
Attorney for Applicant

TEKTRONIX, INC.
P. O. Box 500, MS 50-LAW
Beaverton, Oregon 97077
(503) 627-5068

Attorney's Docket No. 7123-US

Claims Appendix

Claim 1. A circuit for testing a communication system that is subdivided into functional

layers comprises a port that allows communication by a test apparatus directly with any

layer that is higher than a first layer of the functional layers without the communication

previously having to pass through the first layer.

Claim 2. The circuit arrangement according to claim 1 wherein the functional layers

correspond to an OSI reference model.

Claim 3. The circuit arrangement according to claims 1 or 2 wherein the communication

comprises data input into and/or data output from the port .

Claim 4. The circuit arrangement according to claim 3 wherein processing of the

communication is realized on a single chip, with the port being provided on the chip.

Claim 5. The circuit arrangement according to claim 3 wherein processing of the

communication is realized on a first chip and the port is on a second chip, the first and

second chips being linked with each other for data transfer.

Claim 6. A method for testing a switch for a telecommunication network that is

subdivided into functional layers comprising the steps of:

      providing the switch with a circuit arrangement having a port that allows

communication by a test apparatus directly with any layer that is higher than a first layer

of the functional layers without the communication previously having to pass through the

first layer;

    outputting response data from the port to the test apparatus; and

    analyzing the response data by the test apparatus.

Claim 7. The method according to claim 6 further comprising the step of inputting test

data into the port before the outputting step.

Claim 8. The method according to one of claims 6 or 7 wherein the test data comprise a

stimulation signal.

Claim 9. The method according to claim 8 wherein the response data comprise a

response to the stimulation signal.

Claim 10. The method according to claim 6 wherein the response data comprise a

monitoring signal.

Evidence Appendix

No evidence was submitted in this case under Sections 1.130, 1.131 or 1.132 of 37 C.F.R. or entered by the Examiner upon which Appellant is relying in this appeal.

Related Proceedings Appendix

There are no related proceedings related to or which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.